

REMARKS/ARGUMENTS

Claim Changes

Claim 1 has been amended to clarify that the claimed invention is directed to the statutory subject matter of a process. These changes are based at least on FIG. 14 and the accompanying description on page 9, line 21 to page 12, line 9 of the specification as filed. Thus, no new matter has been added. Moreover, Claim 1 includes the limitations of “the field is the synchronization field in a first burst of the plurality of bursts in the superframe and the field is the signaling field in a remainder of the plurality of bursts in the superframe”, which limitations the Office Action dated August 25, 2006 stated were not disclosed or fairly suggested in the prior art, and resulting in the allowability of this claim.

Claim 13 has been amended in response to a claim objection.

Claim 15 has been amended in response to a claim objection.

Claim 17 has been amended in response to a claim objection.

Claim 23 has been amended to clarify that the claimed invention is directed to the statutory subject matter of a process. These changes are based at least on FIG. 14 and the accompanying description on page 9, line 21 to page 12, line 9 of the specification as filed. Thus, no new matter has been added. Moreover, Claim 23 includes the limitations of “the field is the synchronization field in a first burst of the plurality of bursts in the superframe and the field is the signaling field in a remainder of the plurality of bursts in the superframe”, which limitations the Office Action dated August 25, 2006 stated were not disclosed or fairly suggested in the prior art, and resulting in the allowability of this claim.

Claim 24 has been amended to more clearly recite the claimed invention and to clarify that the claimed invention is directed to the statutory subject matter of a process. These changes are based at least on the description on page 3, lines 28-30 and on page 4, lines 15-22 of the specification as filed and FIG. 14 and the accompanying description on page 9, line 21 to page 12, line 9 of the specification as filed. Thus, no new matter has been added.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment was made for the purpose of narrowing the scope of any claim, unless Applicant had argued herein that such amendment was made to distinguish over a particular reference or combination of references. Any remarks made herein with respect to a given claim or amendment are intended only in the context of that specific claim or amendment, and should not be applied to other claims, amendments, or aspects of Applicant's invention.

Allowable Subject Matter

Claims 13-22 are allowed.

Claim Objections

Claims 13, 15 and 17 are objected to because of the following stated informalities: in line 3 of each claim, “comprising payload” should be “comprising a payload”. Claims 13, 15 and 17 are amended to make this correction, without admission that such correction is necessary or that such correction changes the scope of these claims.

In view of the amendments to Claims 13, 15 and 17, Applicant requests that the objections to these claims be withdrawn and Claims 13, 15 and 17 passed to allowance.

Rejection of Claims 1-5, 9, 10, 23 and 24 under 35 U.S.C. §101

Claims 1-5, 9, 10, 23 and 24 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter since the claims are directed to a signal per se. Independent Claims 1, 23 and 24 have each been amended to clarify that the claimed invention is directed to the statutory subject matter of a process. Claims 2-5, 9 and 10 now depend from an independent claim (i.e., Claim 1) directed to the statutory subject matter of a process.

In view of the amendments to Claims 1, 23 and 24, Applicant requests that the rejection of Claims 1-5, 9, 10, 23 and 24 under 35 U.S.C. §101 be withdrawn and Claims 1-5, 9, 10, 23 and 24 passed to allowance.

Rejection of Claim 24 under 35 U.S.C. 103(a) as being unpatentable over Smith, et al. (USPN 6,714,557), in view of Oliver (USPN 6,292,484), and in further view of Cantoni, et al. (USPN RE 37,494)

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, et al. in view of Oliver, and in further view of Cantoni, et al. Applicant has amended Claim 24 to clarify the invention. Applicant therefore respectfully requests reconsideration of the rejection of Claim 24 under 35 U.S.C. §103(a) as being unpatentable over Smith, et al. in view of Oliver, and in further view of Cantoni, et al.

To establish a *prima facie* case of obviousness, and hence to find Claim 24 unpatentable under 35 U.S.C. § 103(a) over the combination of Smith, et al., Oliver and Cantoni, et al., three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based upon applicant's disclosure. MPEP at §2142. In the present case, all three criteria are not met because the combined teachings of the Smith, et al., Oliver and Cantoni, et al. references do not teach or suggest all of the claim limitations of amended Claim 24.

Applicants have amended Claim 24 to now contain the language “the field is used in at least one burst as a synchronization field and in at least one other burst as a signaling field, but not simultaneously as both the synchronization field and the signaling field in any single burst”, which Applicants submit is not taught or suggested in the combined teachings

of the Smith, et al., Oliver and Cantoni, et al. references. This amended language makes clear that the embedded field can only be used as either a synchronization field *or* a signaling field (in the alternative) but not both, at any given time within a single burst. Applicants continue to contend that these limitations are not disclosed in the references.

In view of the foregoing, Applicant submits that Claim 24 is not unpatentable in view of the combined teachings of Smith, et al., Oliver and Cantoni, et al., and therefore submits that the rejection of Claim 24 under 35 USC 103(a) is improper and should be withdrawn. Applicant further requests that Claim 24 now be passed to allowance.

The application is in condition for allowance. Such action is earnestly solicited by the Applicants. In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicant's attorney or agent at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection.

Please charge any fees that may be due to Deposit Account 502117, Motorola, Inc.

Respectfully submitted,

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